Remarks

Amendments to Claims

Claims 14 and 16 have been amended as indicated above. In particular, claims 14 and 16 have been amended to recite the PML object UI_SELECT_OPTION. Support for the amendments to claims 14 and 16 can be found at least on page 2, lines 14-16, and page 5, lines 2-7 of the Instant Application as originally filed. No new matter has been introduced by the amendments to the claims.

Response to Final Office Action dated October 22, 2004

Rejection of Claims under 35 U.S.C. § 102

Claims 14 and 16 stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,559,965 to Simpson et al. ("Simpson").

The Applicants respectfully disagree that claims 14 and 16, as amended, are anticipated by Simpson.

As a starting point, the PTO and the Federal Circuit provide that §102 anticipation requires <u>each and every element</u> of the claimed invention to be disclosed in a single prior art reference. (*In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990)). The corollary of this rule is that the absence from a cited §102 reference of <u>any</u> claimed element <u>negates the anticipation</u>. (*Kloster Speedsteel AB, et al v. Crucible, Inc., et al*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986)). Furthermore, "[a]nticipation requires that **all of the elements and limitations** of the claims are found within a **single prior art reference**." (*Scripps Clinic and Research Found. v Genetech. Inc.,* 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991 (emphasis added)). Moreover, the PTO and the Federal Circuit provide that § 102 anticipation requires that there must be **no difference**

between the claimed invention and the reference disclosure. (*Scripps Clinic and Research Found. v. Genetech, Inc.,* id. (emphasis added)).

Accordingly, if the Applicants can demonstrate that any one element or limitation in claims 14 and 16 is not disclosed by Simpson, then the respective claim(s) must be allowed.

In the following arguments, the Applicants will focus in particular on independent claims 14 and 16, as the Applicants believe those claims to be allowable (as amended above) over Simpson. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable.

Claim 14

The Applicants contend that claim 14, as amended, is not anticipated by Simpson. In regard to claim 14, as amended, that claim includes the following features and limitations:

A method for a client to discover a peripheral address, by way of a peripheral server, the method comprising:

sending a first message to the peripheral server, wherein the first message contains an address of the client, and wherein <u>the print job contains a PML object</u>, and wherein the PML object is <u>UI_SELECT_OPTION</u>; and

receiving at the client a second message containing the peripheral address, wherein the first message is formatted as a print job, the print job including no content resulting in a printed output.

(Emphasis added.)

(Continued on next page.)

Simpson fails to provide a method for a client to discover a peripheral device, the method including sending a first message to the peripheral server, wherein the first message contains an address of the client, and wherein <u>the print job contains a PML object</u>, and wherein the PML object is <u>UI_SELECT_OPTION</u>, as recited in combination with the other features of claim 14, as amended. In fact, Simpson is completely devoid of the PML object UI_SELECT_OPTION, in any context.

Rather, Simpson is directed to establishing two-way communication between a print client and a printer, wherein a print job language (PJL) command known as "SOCKETPING" is used to transmit information between the print client and the printer (Abstract of Simpson). This is not the same as the invention as recited by instant claim 14, as amended. The §102(e) rejection of claim 14, as amended, is unsupportable in view of the deficiencies of Simpson and in light of the requirements for upholding such a rejection as described above.

For at least these reasons, the Applicants assert that claim 14, as amended, is allowable. As claim 15 depends from claim 14, as amended, it is axiomatic that claim 15 is also allowable, at least by virtue of its dependency from an allowable base claim.

Claim 16

The Applicants contend that claim 16, as amended, is not anticipated by Simpson. In regard to claim 16, as amended, that claim includes the following features and limitations:

> An apparatus comprising:
>
> a client computer;
>
> a peripheral server, connected to the client computer, wherein
>
> the peripheral server receives a first message from the client

computer, the first message containing an address of the client computer; and

    a peripheral, connected to the peripheral server, wherein the peripheral receives the first message from the peripheral server and notifies the client computer of the peripheral's address, wherein:

    <u>the first message is formatted as a print job, the print job including no content resulting in a printed output, and wherein the print job contains a PML object, and wherein the PML object is UI_SELECT_OPTION;</u>

    ....

(Emphasis added.)

Simpson fails to provide an apparatus comprising a client computer, a peripheral server and a peripheral, wherein the client computer sends a first message, <u>the first message is formatted as a print job, and wherein the print job contains a PML object, and wherein the PML object is UI_SELECT_OPTION</u>, as recited in combination with the other features of claim 16, as amended. Quite simply, Simpson provides no teachings whatsoever directed to the use of the PML object UI_SELECT_OPTION. Simpson fails to provide at least one element recited by claim 16, as amended. As a result, the corresponding § 102(e) rejection of claim 16, as amended, is invalid and should be withdrawn.

For at least these reasons, the Applicants assert that claim 16, as amended, is allowable. As claims 17-20 depends from claim 16, as amended, it is axiomatic that claims 17-20 are also allowable, at least by virtue of their respective dependencies from an allowable base claim.

(Continued on next page.)

Rejection of Claims under 35 U.S.C. § 103

Claim 15 has been rejected been rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson in view of U.S. Patent No. 6,219,151 to Manglapus et al. ("Manglapus"), and in further view of U.S. Patent No. 6, 728, 012 to Bacher et al. ("Bacher"). Claims 17 and 18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson in view of Manglapus. Claims 19-21, 23-24, 27-29 and 32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson in view of Bacher. Claims 22, 26 and 30-31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson in view of Bacher and in further view of Manglapus. Claim 25 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson in view of Bacher, and in further view of U.S. Patent No. 6,094,548 to Gunning et al. ("Gunning").

The Applicants respectfully disagree that claims 15 and 17-32 are unpatentable as respectively rejected above.

The Applicants assert that U.S. Patent No. 6,559,965 to Simpson et al. is not a valid reference, alone or in any combination, for rejecting any claim or claims of the Instant Application under 35 U.S.C. § 103, in view of 35 U.S.C. § 103(c). The Applicants respectfully bring the following facts to the Examiner's attention:

1) U.S. Patent No. 6,559,965 to Simpson et al. and the Instant Application are of respectively different inventive entities, wherein Mr. Matt Howell is the only person common to each. Thus, U.S. Patent No. 6,559,965 to Simpson et al. constitutes subject matter developed by another person with respect to the Instant Application.

2) U.S. Patent No. 6,559,965 to Simpson et al. was assigned in its entirety to Hewlett-Packard Company, Fort Collins, Colorado, as recorded at Reel/Frame No. 010389/0556 on November 15, 1999. The Instant Application was assigned in its entirety to Hewlett-Packard Company, Fort Collins, Colorado, as recorded at Reel/Frame No. 011680/0892 on March 26, 2001. Thus, U.S. Patent No. 6,559,965

1 to Simpson et al., and the Instant Application and any Patent(s) issuing therefrom,

2 were owned by the same person at the time the present invention was made.

3   3) U.S. Patent No. 6,559,965 to Simpson et al. qualifies as prior art only

4 under one or more of subsections (e), (f), and (g) of 35 U.S.C. § 102, with respect to

5 the Instant Application.

6   In view of facts 1), 2) and 3) above, and in further view of 35 U.S.C. § 103(c),

7 the Applicants contend that U.S. Patent No. 6,559,965 to Simpson et al. does not

8 preclude patentability of the claims of the Instant Application under 35 U.S.C. § 103.

9 The Applicants assert that the respective § 103 rejections of claims 15 and 17-32

10 are invalid by virtue of the non-applicability of U.S. Patent No. 6,559,965 to Simpson

11 et al. as a prior art reference for such rejections.

12   The Applicants assert that claims 15 and 17-32 are allowable for at least

13 these reasons, as well as for their own respectively patentable features and

14 limitations.

15

16   Summary

17   The Applicants believe that this response constitutes a full and complete

18 response to the Final Office Action dated October 22, 2004, as well as a complete

19 submission to accompany Request for Continued Examination in accordance with 37

20 CFR 1.114. Therefore, the Applicants respectfully request examination on the merits

21 of claims 14-32, as respectively amended, in favor of timely allowance thereof.

22   The Examiner is respectfully requested to contact the below-signed

23 representative if the Examiner believes this will facilitate prosecution toward allowance of

24 the claims.

25

Respectfully submitted,

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